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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,478	10/07/2003	Steven P. Adams	14406-003006	6640
26171	7590	09/04/2007		
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER AULAKH, CHARANJIT	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 09/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/679,478

Applicant(s)

ADAMS ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. Claims 1-22 are pending in the application.

#### ***Election/Restrictions***

2. Claims 1-22 are generic to the following disclosed patentably distinct species:

Species I : Compounds of formula (I) where R1 and R3 represent alkyl, alkenyl or alkynyl group and R4 represents H, alkyl, alkenyl or alkynyl group.

Species II : Compounds of formula (I) where R1 and R3 represent alkyl, alkenyl or alkynyl group and R4 represents cycloalkyl or cycloalkenyl group.

Species III: Compounds of formula (I) where R1 and R3 represent alkyl, alkenyl or alkynyl group and R4 represents aminocarbonyl, mono- or dialkylaminocarbonyl or mono- or diacylaminocarbonyl group.

Species IV : Compounds of formula (I) where R1 and R3 represent alkyl, alkenyl or alkynyl group and R4 represents amido group.

Species V : Compounds of formula (I) where R1 and R3 represent alkyl, alkenyl or alkynyl group and R4 represents aliphatic acyl group.

Species VI : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents cycloalkyl or cycloalkenyl group and R4 represents H, alkyl, alkenyl or alkynyl group.

Species VII : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents cycloalkyl or cycloalkenyl group and R4 represents cycloalkyl or cycloalkenyl group.

Art Unit: 1625

Species VIII: Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents cycloalkyl or cycloalkenyl group and R4 represents aminocarbonyl, mono- or dialkylaminocarbonyl or mono- or diacylaminocarbonyl group.

Species IX : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents cycloalkyl or cycloalkenyl group and R4 represents amido group.

Species X: Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents cycloalkyl or cycloalkenyl group and R4 represents aliphatic acyl group.

Species XI : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents specific amino acid and R4 represents H, alkyl, alkenyl or alkynyl group.

Species XII : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents specific amino acid and R4 represents cycloalkyl or cycloalkenyl group.

Species XIII : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents specific amino acid and R4 represents aminocarbonyl, mono- or dialkylaminocarbonyl or mono- or diacylaminocarbonyl group.

Species XIV : Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents specific amino acid and R4 represents amido group.

Species XV: Compounds of formula (I) where R1 represents alkyl, alkenyl or alkynyl group, R3 represents specific amino acid and R4 represents aliphatic acyl group.

Species XVI : Compounds of formula (I) where R1 represents cycloalkyl or cycloalkenyl group, R3 represents specific amino acid and R4 represents H, alkyl, alkenyl or alkynyl group.

Species XVII : Compounds of formula (I) where R1 represents cycloalkyl or cycloalkenyl group, R3 represents specific amino acid and R4 represents cycloalkyl or cycloalkenyl group.

Species XVIII : Compounds of formula (I) where R1 represents cycloalkyl or cycloalkenyl group, R3 represents specific amino acid and R4 represents aminocarbonyl, mono- or dialkylaminocarbonyl or mono- or diacylaminocarbonyl group.

Species XIX : Compounds of formula (I) where R1 represents cycloalkyl or cycloalkenyl group, R3 represents specific amino acid and R4 represents amido group.

Species XX : Compounds of formula (I) where R1 represents cycloalkyl or cycloalkenyl group, R3 represents specific amino acid and R4 represents aliphatic acyl group.

Species XXI : Compounds of formula (I) where R1 represents alkoxy, alkenoxy or alkynoxy group, R3 represents specific amino acid and R4 represents H, alkyl, alkenyl or alkynyl group.

Species XXII : Compounds of formula (I) where R1 represents alkoxy, alkenoxy or alkynoxy group, R3 represents specific amino acid and R4 represents cycloalkyl or cycloalkenyl group.

Species XXIII : Compounds of formula (I) where R1 represents alkoxy, alkenoxy or alkynoxy group, R3 represents specific amino acid and R4 represents aminocarbonyl, mono- or dialkylaminocarbonyl or mono- or diacylaminocarbonyl group.

Art Unit: 1625

Species XXIV : Compounds of formula (I) where R1 represents alkoxy, alkenoxy or alkynoxy group, R3 represents specific amino acid and R4 represents amido group.

Species XXV : Compounds of formula (I) where R1 represents alkoxy, alkenoxy or alkynoxy group, R3 represents specific amino acid and R4 represents aliphatic acyl group.

Species XXVI : Compounds of formula (I) where R1 represents alkylamino, alkenylamino, alkynylamino, N-alkylurea, alkylcarbonylamino or aminocarbonyl group, R3 represents specific amino acid and R4 represents H, alkyl, alkenyl or alkynyl group.

Species XXVII : Compounds of formula (I) where R1 represents alkylamino, alkenylamino, alkynylamino, N-alkylurea, alkylcarbonylamino or aminocarbonyl group, R3 represents specific amino acid and R4 represents cycloalkyl or cycloalkenyl group.

Species XXVIII : Compounds of formula (I) where R1 represents alkylamino, alkenylamino, alkynylamino, N-alkylurea, alkylcarbonylamino or aminocarbonyl group, R3 represents specific amino acid and R4 represents aminocarbonyl, mono- or dialkylaminocarbonyl or mono- or diacylaminocarbonyl group.

Species XXIX : Compounds of formula (I) where R1 represents alkylamino, alkenylamino, alkynylamino, N-alkylurea, alkylcarbonylamino or aminocarbonyl group, R3 represents specific amino acid and R4 represents amido group.

Species XXX : Compounds of formula (I) where R1 represents alkylamino, alkenylamino, alkynylamino, N-alkylurea, alkylcarbonylamino or aminocarbonyl group, R3 represents specific amino acid and R4 represents aliphatic acyl group.

3. The species I through XXX as defined above are independent or distinct because they are structurally so divergent that a reference showing compounds of species I would not render compounds of species II through XXX prima facie obvious. Search required for species I is not the same search required for species II through XXX since each species mentioned above requires a different structure query for structure searching and therefore, causes burdensome search.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

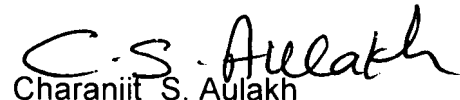
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Charanjit S. Aulakh  
Primary Examiner  
Art Unit 1625